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One AT&T Way

Room 2A-207

Bedminster, NJ 07921

EXAMINER

NASH, LASHANYA RENEE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/747,755	Applicant(s) ARNOFF, MARY S.	
	Examiner LASHANYA R. NASH	Art Unit 2453	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5, 7-13, 15 and 17-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5 and 7-13, 15, 17-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/25/09, 4/21/09</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to the amendment filed 25 June 2009. Claims 1-2 have been withdrawn. Claim 6 is cancelled. Claims 3, 7-9, 15, 17 and 24 are currently amended. Claims 3-5 and 7-13, 15, 17-30 are presented for further consideration. Claims 6, 14 and 16 are presented for further consideration.

Response to Arguments

The objection to claims 7, 8 and 9 are withdrawn, in light of the amendments.

The rejections of claims 4, 5, 19, 20, 21, 25, 26, 28, 29 and 30 under 35 USC § 112, second paragraph remain rejected as set forth below in the Office action. Examiner notes that Applicant contends that the term "substantial" is widely accepted. However, the Examiner maintains that there is **no standard for ascertaining the requisite degree of this terminology provided in the specification or the claim itself.**

Therefore, it is unclear the range that would properly constitute a conversion and receiving of a communication that is occurring "substantially synchronously". Conflicting interpretations of the claim language could result (i.e. conversion completed after receiving; receiving completed after conversion), thereby rendering the claims indefinite.

Applicant's arguments, see Remarks, filed 25 June 2009, with respect to the rejections of claims under have been fully considered and are persuasive in light of the amendments. Therefore, the rejection has been withdrawn. However, upon further

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consideration, a new grounds of rejection is made in view of a new interpretation of a previously applied prior art reference Zafar et al. (US Patent 7,142,646), as set forth below in the Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4,5,19,20,21,25,26,28,29 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "substantially" in the claims is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5 and 7-13, 15, 17-30 rejected under 35 U.S.C. 102(a) as being unpatentable over Segur (US Patent 6,212,55) in view of Brusilovsky et al. ("A Proposal for Internet Call Waiting Service Using SIP"-retrieved from Internet) BS Zafar et al. (US Patent 7,142,646), hereinafter referred to as Segur, Brusilovsky and Zafar .

In reference to claim 3, Segur discloses a system for converting messages between multiple communication interfaces. Segur discloses:

- A system for integrating standard communication modalities (column 1, lines 58-65; Figure 1), the system comprising:
- a system configured to communicate using a first standard communication protocol (plurality of communication interfaces; column 2, lines 27-47; Figure 2);
- a second communication system configured to communicate using a second standard communication protocol (plurality of communication interfaces; column 2, lines 27-47; Figure 2); and
- a messaging server (i.e. multi-format communications server; column 1, lines 65-67), communicatively coupled to the first communication system the messaging server further being communicatively coupled to the second communication system (column 2, lines 45-55), the messaging server being configured to receive a first communication from the first communication system using the first standard communication protocol, the messaging server being further configured to convert the first communication into a

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second communication, the second communication being compatible with the second standard communication protocol (column 2, line 56-column 3, line 2), the messaging server being further configured to transmit the second communication to the second communication system using the second standard communication protocol (column 3, lines 55-65).

However, the reference fails to disclose that the system is an Internet call waiting (ICW) system configured to communicate using a first standard communication protocol; and sending a query to determine whether the callee is a subscriber of the second communication system. Nonetheless, this was a well known feature in the art at the time of the invention, as further evidenced by Brusilovsky. Therefore, it would have been obvious to accordingly modify the teachings of Segur for one of ordinary skill in the art at the time of the invention.

In an analogous art, Brusilovsky discloses a system for providing ICW services to dial-up internet users (abstract). Brusilovsky further discloses that Internet call waiting (ICW) system configured to communicate using a first standard communication protocol (i.e. ICW communicate via the SIP protocol over TCP/IP; 3. *Scope of the Proposed Project*, paragraph 2, page 2); and sending a query to determine whether the callee is a subscriber of the second communication system, (i.e. query to determine subscriber; *Call Arrival*, page 8). One of ordinary skill in the art would have been motivated to accordingly modify the system of Segur so as to interconnect the IP and Switched Telephone Networks providing ICW services, based on the open well-defined protocols (Brusilovsky; Abstract). Although Segur and Brusilovsky disclose

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multiple communication interfaces, the reference fails to disclose the system wherein the Internet Call Waiting (ICW) system includes an email system and an instant messaging (IM) system. Nonetheless, this was a well known feature in the art at the time of the invention, as further evidenced by Zafar.

In an analogous art, Zafar discloses a unified messaging system Internet Call Waiting (ICW) system includes an email system (column 7, lines 49-55; column 10, lines 4-10) and an instant messaging (IM) system (IM) system (column 2, lines 7-22). One of ordinary skill in the art at the time of the invention would have been so motivated to include the IM system, as taught by Zafar, to the multiple communication interfaces of the system as taught by Segur, so as provide further unified messaging between data processing (Internet) and telephony (i.e. voicemail) systems (Zafar; column 1, lines 60-65).

In reference to claim 24, Segur discloses a method for converting messages between multiple communication interfaces. Segur discloses:

- A method for integrating standard communication modalities (column 1, lines 58-65; column 3, lines 24-26), the method comprising the steps of:
- receiving a first communication from a system, the first communication being compatible with a first standard communication protocol (plurality of communication interfaces; column 1, lines 65-column 2, line 2; column 2, lines 27-47);

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- converting the first communication into a second communication at a messaging server (column 2, lines 24-26; column 2, line 56-column 3, line 2); and
- transmitting the second communication to a second communication system using the second standard communication protocol (column 2, lines 24-26; column 3, lines 55-65).

However, the reference fails to disclose that the system is an Internet call waiting (ICW) system, the first communication being compatible with a first standard communication protocol; and sending a query to determine whether the callee is a subscriber of the second standard communication protocol; in response to a determination that the callee is a subscriber of the messaging system associated with the second standard communication protocol. Nonetheless, this was a well known feature in the art at the time of the invention, as further evidenced by Brusilovsky. Therefore, it would have been obvious to accordingly modify the teachings of Segur for one of ordinary skill in the art at the time of the invention.

In an analogous art, Brusilovsky discloses a system for providing ICW services to dial-up internet users (abstract). Brusilovsky further discloses that Internet call waiting (ICW) system, the first communication being compatible with a first standard communication protocol (i.e. ICW communicate via the SIP protocol over TCP/IP; 3. *Scope of the Proposed Project*, paragraph 2, page 2); and sending a query to determine whether the callee is a subscriber of the second standard communication protocol; in response to a determination that the callee is a subscriber of the messaging system

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associated with the second standard communication protocol, (i.e. query to determine subscriber; *Call Arrival*, page 8). One of ordinary skill in the art would have been motivated to accordingly modify the system of Segur so as to interconnect the IP and Switched Telephone Networks providing ICW services, based on the open well-defined protocols (Brusilovsky; Abstract). Although Segur and Brusilovsky disclose multiple communication interfaces, the reference fails to disclose the system wherein the Internet Call Waiting (ICW) system includes an email system and an instant messaging (IM) system. Nonetheless, this was a well known feature in the art at the time of the invention, as further evidenced by Zafar.

In an analogous art, Zafar discloses a unified messaging system Internet Call Waiting (ICW) system includes an email system (column 7, lines 49-55; column 10, lines 4-10) and an instant messaging (IM) system (column 2, lines 7-22). One of ordinary skill in the art at the time of the invention would have been so motivated to include the IM system, as taught by Zafar, to the multiple communication interfaces of the system as taught by Segur, so as provide further unified messaging between data processing (Internet) and telephony (i.e. voicemail) systems (Zafar; column 1, lines 60-65).

In reference to claim 4, Segur discloses wherein the conversion of the first communication into the second communication occurs substantially synchronously with the receiving of the first communication (column 2, lines 18-26).

In reference to claim 5, Segur discloses, wherein the transmission of the second communication occurs substantially synchronously with the converting of the first communication into the second communication (column 2, lines 24-26).

In reference to claim 7, Segur discloses the system wherein the second communication system is a legacy voicemail system (i.e. voice messages; column 2, lines 43-45).

In reference to claim 8, Segur discloses the system wherein the second communication system is an email system (column 2, lines 40-43).

In reference to claim 9, Zafar discloses wherein the second communication system is an instant messaging (IM) system (column 2, lines 7-22).

In reference to claims 10, Brusilovsky discloses the system, wherein the Internet call waiting system includes a legacy voicemail system (i.e. GSTN, abstract).

In reference to claim 11, Segur discloses the system, wherein the second communication system is an email system (column 2, lines 40-43).

In reference to claim 12, Zafar discloses wherein the second communication system is an instant messaging (IM) system (column 2, lines 7-22).

In reference to claim 13, Brusilovsky discloses the system wherein the second communication system is an Internet call waiting (ICW) system (i.e. ICW client and server; 3. *Scope of the Proposed Project*; paragraph 2, page 2).

In reference to claim 14, Segur discloses the system wherein the first communication system is an email system (column 2, lines 40-43).

In reference to claim 15, Segur discloses the system, wherein the second communication system is a legacy voicemail system (i.e. voice messages; column 2, lines 43-45).

In reference to claim 16, Brusilovsky discloses where the Internet call waiting system includes an instant messaging (IM) system (2. *Service description*, page 2)

In reference to claim 17, Segur discloses the system, wherein the second communication system is a legacy voicemail system (i.e. voice messages; column 2, lines 43-45).

In reference to claim 18, Segur discloses the system, further comprising a third communication system configured to communicate using a third standard communication protocol, wherein the messaging server is further communicatively

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coupled to the third communication system (plurality of communication interfaces; column 2, lines 27-47; Figure 2), the messaging server being further configured to convert the first communication into a third communication, the third communication being compatible with the third standard communication protocol (column 2, line 56-column 3, line 2), the messaging server being further configured to transmit the third communication to the third communication system using the third standard communication protocol (column 2, lines 24-26; column 3, lines 55-65).

In reference to claim 19, Segur discloses the system, wherein the transmission of the second communication is substantially synchronous with the transmission of the third communication (i.e. multiple converted messages are transmitted; column 3, lines 55-65).

In reference to claim 20, Segur discloses the system of claim 18, wherein the conversion of the first communication into the third communication occurs substantially synchronously with the receiving of the first communication (column 2, lines 18-26).

In reference to claim 21, Segur discloses the system, wherein the transmission of the third communication occurs substantially synchronously with the converting of the first communication into the third communication (column 3, lines 55-65).

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In reference to claim 22, Segur discloses the system: wherein the first communication system is different from the second communication system; wherein the second communication system is different from the third communication system; wherein the third communication system is different from the first communication system (plurality of communication interfaces; column 2, lines 27-47; Figure 2-items 52,54,56,58,60,62,64) ; and wherein the first communication system, the second communication system, and the third communication system are each selected from the group consisting of: a public switched telephone network (PSTN) telephone system (column 2, lines 43-46); a cellular telephone system (column 2, lines 36-38); an email system (column 2, lines 40-43); an instant messaging (IM) system; an Internet call waiting (ICW) system; and an legacy voicemail system (i.e. voice messages; column 2, lines 43-45).

In reference to claim 23, Segur discloses the system, the first communication system being selected from the group consisting of: a public switched telephone network (PSTN) telephone system (column 2, lines 43-46); a cellular telephone system (column 2, lines 36-38); an Internet call waiting (ICW) system; and the second communication system being different from the first communication system, the second communication system being selected from the group consisting of: a public switched telephone network (PSTN) telephone system (column 2, lines 36-38); a cellular telephone system (column 2, lines 36-38); an email system (column 2, lines 40-43); an instant messaging (IM) system; an Internet call waiting (ICW) system; and an legacy

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voicemail system (i.e. voice messages; column 2, lines 43-45); and the third communication system being different from the second communication system, the third communication system further being different from the second communication system (plurality of communication interfaces; column 2, lines 27-47; Figure 2), the third communication system being selected from the group consisting of: a public switched telephone network (PSTN) telephone system (column 2, lines 43-46); a cellular telephone system (column 2, lines 36-38); an email system (column 2, lines 40-43); an instant messaging (IM) system; an Internet call waiting (ICW) system; and an legacy voicemail system (i.e. voice messages; column 2, lines 43-45).

In reference to claim 25, Segur discloses the method of claim 24, wherein the step of receiving the first communication and the step of converting the first communication into the second communication occur substantially synchronously (column 2, lines 18-26).

In reference to claim 26, Segur discloses the method, wherein the step of converting the first communication into the second communication and the step of transmitting the second communication occur substantially synchronously (column 2, lines 24-26).

In reference to claim 27, Segur discloses the method, further comprising the steps of: converting the first communication into a third communication, the third

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communication being compatible with a third standard communication protocol (column 2, line 56-column 3, line 2); and transmitting the third communication to a third communication system using the third standard communication protocol (column 3, lines 55-65).

In reference to claim 28, Segur discloses the method, wherein the step of transmitting the second communication and the step of transmitting the third communication occur substantially synchronously (i.e. multiple converted messages are transmitted; column 3, lines 55-65).

In reference to claim 29, Segur discloses the method, wherein the step of receiving the first communication and the step of converting the first communication into the third communication occur substantially synchronously (column 2, lines 18-26).

In reference to claim 30, Segur discloses the method, wherein the step of converting the first communication into the third communication and the step of transmitting the third communication occur substantially synchronously (column 2, lines 55-65).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LASHANYA R. NASH whose telephone number is (571)272-3957. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LaShanya R Nash/
Examiner, Art Unit 2453
July 27, 2009

/ARIO ETIENNE/
Supervisory Patent Examiner, Art Unit 2457